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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/328,356	10/24/94	CONNOLLY	D. 1124.025

26M2/1212  
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TROST EXAMINER	
ART UNIT	PAPER NUMBER
2608	6

DATE MAILED:

12/12/95

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

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1. This application filed under 37 C.F.R. § 1.60 lacks the necessary reference to the prior application. A statement reading "which is a continuation of application Serial No. 08/000,363, filed 1/4/93, now Patent No. 5,325,418" should be entered following the statement that this application is a continuation-in-part of application Serial No. 08/184,298. *Also, the present status of all parent applications should be included.*

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 C.F.R. § 1.67(a) identifying this application by its Serial Number and filing date is required. See M.P.E.P. §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. § 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose material information as defined in 37 C.F.R. § 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

3. The formal drawings have been received on 2/6/95. These drawings are approved by the draftsman.

4. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or

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provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-102 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-65 of U.S. Patent No. 5,325,418 in view of West, Jr. et al (hereinafter West).

Regarding claims 1-102, U.S. Patent No. 5,325,418 (hereinafter Connolly) discloses a wireless personal communications system (PCS) which comprises intelligent handsets, intelligent base stations, and allows for two-way voice/data/image calls and intercell hand-off, where the PCS network uses ISDN and AIN technologies, and the network contains the intelligent handset features and profiles (See claims 1-65). Connolly fails to disclose the use of fixed terminals which communicate with the wireless network.

On the other hand, West teaches the use of fixed terminals (310) which interface wired telephones (1) to the cellular system (302) via base stations (304). West further teaches that wired telephone (1) functions as a telephone of the cellular system (abstract, Col. 2;10-Col. 3;45). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to add fixed terminals to a wireless network, as taught by West, to Connolly, in order to allow obviate the need for costly telephone line installation.

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6. The disclosure is objected to because of the following informalities: the title is objected to as being too long. Examiner suggests "Wireless Digital Personal Communications System Having Voice/Data/Image Two-Way Calling and Intercell Hand-off". Appropriate correction is required.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bendixen et al disclose the use of fixed terminals which can access the cellular network.

Harris discloses a cellular pay station.


Brennan et al disclose the storing of profile information in a PCS system for wired and wireless subscribers.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Trost whose telephone number is (703) 308-5318. The examiner can normally be reached on Monday-Thursday from 8 a.m to 5 p.m. The examiner can also be reached on alternate Fridays. The fax phone number for this Group is (703) 305-9508.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.



William Trost  
December 1, 1995



CURTIS KUNITZ  
SUPERVISORY PATENT EXAMINER  
GROUP 2608